

Application No.: 09/919,202

File No.: 1-15207

**REMARKS**

Favorable reconsideration of this application in the light of the amendments and the following discussion is respectfully requested. Applicant appreciates the cooperation of Examiner Thanh in discussing this application during the telephone interview with applicant's undersigned counsel on November 17, 2004. Subject to the Examiner's review of this amendment, agreement was reached during the telephone interview as to the patentability of the amended claims over the Kravitz reference.

Claim 1 has been amended to more particularly define the invention as discussed during the interview. Support for the amendments to claim 1 can be found, for example, in the specification at page 6 lines 3-5, page 7 lines 26-27, page 8 lines 5-7 and lines 15-18, page 9 lines 13-14, original claim 8, and the drawings. Claims 8 and 28-30 have been cancelled. Claim 9 has been amended to change the dependency from claim 8 to claim 1. New claims 54-55 have been added. Support for the new claims can be found, for example, in the drawings. No new matter has been added. Claims 1-7, 9-12, 54 and 55 remain in the application for consideration.

**Claim Rejections - 35 USC § 102**

Claims 1-2, 7-10, 12 and 28-30 stand rejected under 35 U.S.C. 102(b) as being anticipated by Kravitz (U.S. Patent No. 3,620,209).

The Office Action indicates that Kravitz teaches a method of reducing pain associated with skin penetration at a site with a needle comprising urging a skin-engaging surface (formed by 32 on the casing) of a pressure member (10) against the skin (12). The Examiner has taken the position that it is inherent that stimulation of the

Application No.: 09/919,202

File No.: 1-15207

large diameter afferent sensory fibers and blocking of pain signal from the small diameter afferent pain nerve fibers in the skin proximate the site occurs since the device of Kravitz is similar in structure with the claimed device of applicant. Kravitz discloses that the pain normally associated with the injection at the area is reduced or minimal. (See abstract). With respect to the language "to thereby depress the skin with sufficient force" (deemed "functional language" in the Office Action), the prior art was considered to be capable of performing the intended use lacking any further structural distinguishing features. Although it was acknowledged that applicant has a method claim, it was considered inherently encompassed by the use of Kravitz's device. It was suggested to claim a distinguishing structural feature or a distinguishing method step that is not inherently performed by the device of Kravitz.

#### **Response to Claim Rejections - 35 USC § 102**

Applicant respectfully traverses the rejection of claims 1-2, 7-10, 12 and 28-30 as being unpatentable over Kravitz. The method of Kravitz relies solely on vibrations at the surface of the skin. While applicant continues to maintain that Kravitz does not teach or suggest urging a skin engaging surface of a pressure member against the skin of a patient proximate the site, to thereby depress the skin with sufficient force to stimulate the large diameter afferent sensory nerve fibers in the skin proximate the site and at least partially block pain signals from the small diameter afferent pain nerve fibers in the skin proximate the site, claim 1 has been amended to include structural features clearly lacking in Kravitz in order to advance prosecution of the application, as discussed during the interview of November 17, 2004.

Application No.: 09/919,202

File No.: 1-15207

Thus, claim 1 has been amended to define the pressure member utilized in the method as "having a generally flat disk shape" with "a skin engaging surface comprised of a plurality of projections extending from said pressure member."

In contrast, the Kravitz device provides a narrow, horseshoe-shaped pressure member with a corresponding skin engaging surface. Kravitz fails to teach or suggest a pressure member that has a generally flat disk shape, and a pressure member having such a shape having a plurality of projections extending therefrom.

Accordingly, Kravitz fails to disclose all of the elements of the claimed invention, arranged as in the claim. The rejection of claim 1 as anticipated by Kravitz should be withdrawn. Claims 2, 7, 9, 10, 12, and new claims 54 and 55 all depend from claim 1 28, and are patentable over Kravitz at least on that basis.

#### **Claim Rejections - 35 USC § 103**

Claims 3-6 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kravitz.

It is asserted that Kravitz discloses the claimed invention except for the material of the pressure member to be flexible, polymeric rigid or metal. As conceded by the Examiner, Kravitz is silent to the materials of the pressure member. However, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the materials of the pressure member to suit the area to which it would applied to, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice.

Application No.: 09/919,202

File No.: 1-15207

---

With respect to claim 11, the Examiner acknowledges that Kravitz does not show a generally cloverleaf shape pressure member. Again, however, the Examiner takes the position that it would have been an obvious design choice to modify the horseshoe or u-shaped design of the Kravitz with a cloverleaf shape lacking any criticality of the shape. The Examiner is taking the position that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. The particular shape of a product is of no patentable significance since it appears to be a matter of choice that a person of ordinary skill in the art would find obvious absent persuasive evidence that the particular configuration of the claimed container was significant.

#### **Response to Claim Rejections - 35 USC § 103**

For all of the reasons presented previously, applicant respectfully traverses the rejection of claims 3-6 and 11 as unpatentable over Kravitz. However, these claims depend, either directly or indirectly, from claim 1 and are patentable at least on that basis. The rejections should therefore be withdrawn.

#### **CONCLUSION**

Favorable reconsideration of the present application and the passing of this case to issue with all pending claims allowed are courteously solicited. In the event the Examiner would prefer language other than that currently set forth in the claims, or should the Examiner wish to discuss any other aspect of this application, applicant's

Application No.: 09/919,202

File No.: 1-15207

attorney earnestly suggests a telephone interview, as proposed by the Examiner, in order to expedite the prosecution of the application.

Respectfully submitted,



Donald A. Schurr  
Reg. No. 34, 247

Marshall & Melhorn, LLC  
Four SeaGate, Eighth Floor  
Toledo OH 43604  
(419) 249-7148